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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,731	02/15/2002	Ken Pallett	514413-3915	4744

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EXAMINER	
CLARDY, S	

ART UNIT	PAPER NUMBER
1616	

DATE MAILED: 05/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/049,731	PALLETT, KEN	
	Examiner	Art Unit	
	S. Mark Clardy	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 March 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-57* is/are pending in the application.

4a) Of the above claim(s) *4-6,10,29-35,45,46,49 and 50* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,7-9,11-28,36-44,47,48 and 51-57* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Claims 1-44, and new claims 45-57 are pending in this application.

Applicant's elected species is the composition comprising the benzoylisoxazole herbicide isoxaflutole[1] (compound A), in combination with the diphenylisoxazolecarboxylic acid safener isoxadifen[2].

The elected species has been expanded to include any safener in combination with the elected herbicide, isoxaflutole, or carboxylate derivatives thereof.

It was previously indicated that no claims had been withdrawn; however, upon further review of the previously presented claims, as well as those amended on March 1, 2004, the following claims have been held withdrawn from further examination as being drawn to non-elected species: claims 4-6, 10, 29-35, 45, 46, 49, 50. (Note that non-elected claims 4 and 6, dependent from claim 1, lack antecedent basis for formulae Ia and Ib, which occur in claims 2 and 3, respectively.)

Claims 1-3, 7-9, 11-28, 36-44, 47, 48, and 51-57 have been examined only insofar as they read on the expanded elected species. Since the combination of isoxaflutole + isoxadifen would be allowable but for the prior issuance of the patent to Ruegg (see below), applicants may want to request that an interference be initiated with respect to the elected species.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15, 18, and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 15 and 18 refer to derivatives of "formula I" but are

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[1] Isoxaflutole: 5-cyclopropyl-4(2-methylsulfonyl-4-trifluoromethylbenzoyl)isoxazole

neither dependent from claim 1 wherein the formula is defined, nor repeat a definition for formula I. Claim 19 does not further limit the product of claim 18 because the additional limitation is a method step which is improper for a product or composition claim.

Claims 20-22 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 1, 15, and 18. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). It is not seen how referring back to an earlier claim "substantially as hereinbefore described" further limits anything.

Claims 1-3, 7-9, 11-28, 36-44, 47, 48, and 51-57 are rejected under 35 U.S.C. 135(a) based upon claims 1-12 of Patent No. 6,489,267 (Ruegg). Ruegg, again, discloses the combination of isoxaflutole and isoxadifen (claim 10). Applicants' claims drawn specifically to this single combination would be allowable but for the patent to Ruegg.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002

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[2] Isoxadifen: 5,5-diphenylisoxazoline-3-carboxylic acid

do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-3, 7, 9, 15, 18, 20-22, 42, 47, and 48 are rejected under 35 U.S.C. 102(a) and (e) as being anticipated by Forget et al (USA 5,905,057).

Forget et al teach the combination of the benxoylisoxazole herbicides such as the ethyl 3-carboxylate derivative of isoxaflutole (col 2, lines 1-46) with safeners such as flurazole, R-29148, furilazole, dichlormid, and benoxacor (col 4, lines 8-15), and surfactants (column 3).

Claims 1-3, 7-9, 11, 15, 18, 20-22, 41-43, 47, 48, and 51-53 are rejected under 35 U.S.C. 102(a) and (e) as being anticipated by Penner et al (US 6,235,682).

Penner et al teach the combination of isoxaflutole with metolachlor and the safener benoxacor for use in corn (see examples), with optional additional adjuvant material (col 5, lines 37-53).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3, 7-9, 11-25, 36, 42-44, 47, 48, 51-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Forget et al and Penner et al, cited above. These patents both teach that isoxaflutole and related carboxylate ester derivatives thereof may

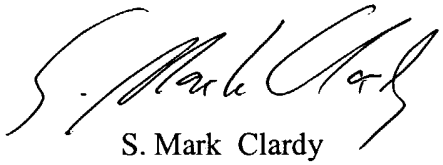
be combined with safening agents for application to crops. Penner et al further teaches the utility of such compositions for corn crops, among others. The determination of appropriate concentration ratios or application protocols is within the skill level of the ordinary artisan.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Mark Clardy whose telephone number is 571-272-0611. The examiner can normally be reached on 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



S. Mark Clardy
Primary Examiner
Art Unit 1616

May 10, 2004